

### **REMARKS**

The Official Action mailed December 14, 2004, has been received and its contents carefully noted. This response is filed within three months of the mailing date of the Official Action and therefore is believed to be timely without extension of time. Accordingly, the Applicants respectfully submit that this response is being timely filed.

The Applicants note with appreciation the consideration of the Information Disclosure Statement filed on July 8, 2003. The Applicants note the *partial* consideration of the Information Disclosure Statement filed on October 28, 2003 (received by OIPE on October 30, 2003). Specifically, it appears that the Examiner inadvertently overlooked the citation of JP 11-237635. A copy of the partially considered Form PTO-1449 is available in the Image File Wrapper under the heading, "List of References cited by Applicant" and has a mail room date of "12/14/2004." The Applicants respectfully request that the Examiner provide an initialed copy of the Form PTO-1449 evidencing consideration of JP '635.

Claims 1-15 are pending in the present application, of which claims 1-3 are independent. Claims 1-3 have been amended to better recite the features of the present invention. For the reasons set forth in detail below, all claims are believed to be in condition for allowance. Favorable reconsideration is requested.

Paragraph 2 of the Official Action rejects claims 1-3 as anticipated by U.S. Patent No. 5,893,625 to Tamatani et al. The Applicants respectfully submit that an anticipation rejection cannot be maintained against the independent claims of the present application, as amended.

As stated in MPEP § 2131, to establish an anticipation rejection, each and every element as set forth in the claim must be described either expressly or inherently in a single prior art reference. Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

The Applicants respectfully submit that an anticipation rejection cannot be maintained against the independent claims of the present application, as amended.

Specifically, claims 1-3 have been amended to recite that a severance process is performed after an injection process. The Applicants respectfully submit that Tamatani does not teach the above-referenced features of the present invention, either explicitly or inherently.

Since Tamatani does not teach all the elements of the independent claims, either explicitly or inherently, an anticipation rejection cannot be maintained. Accordingly, reconsideration and withdrawal of the rejections under 35 U.S.C. § 102 are in order and respectfully requested.

Paragraph 4 of the Official Action rejects claims 4-6 as obvious based on the combination of Tamatani and U.S. Patent No. 6,239,855 to Nakahara et al. Paragraph 5 of the Official Action rejects claims 7-15 as obvious based on the combination of Tamatani and U.S. Patent Application Publication No. 2002/0024621 to Hirakata et al. The Applicants respectfully submit that a *prima facie* case of obviousness cannot be maintained against the independent claims of the present application, as amended.


As stated in MPEP §§ 2142-2143.01, to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. "The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art." In re Kotzab, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000). See also In re Fine, 837 F.2d 1071, 5

USPQ2d 1596 (Fed. Cir. 1988); In re Jones, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

Please incorporate the arguments above with respect to the deficiencies in Tamatani. Nakahara and Hirakata do not cure the deficiencies in Tamatani. The Official Action relies on Nakahara and Hirakata to allegedly teach the features of the dependent claims. Specifically, the Official Action relies on Nakahara to allegedly teach "the use of scribing and a break or cut off process" (page 3, Paper No. 20041102) and on Hirakata to allegedly teach "the use of smectic ferroelectric liquid crystal" (page 4, Id.) and "monostabilization treatment" (pages 4-5, Id.). However, Tamatani and Nakahara or Hirakata, either alone or in combination, do not teach or suggest that a severance process is performed after an injection process. Since Tamatani and Nakahara or Hirakata do not teach or suggest all the claim limitations, a *prima facie* case of obviousness cannot be maintained. Accordingly, reconsideration and withdrawal of the rejections under 35 U.S.C. § 103(a) are in order and respectfully requested.

Should the Examiner believe that anything further would be desirable to place this application in better condition for allowance, the Examiner is invited to contact the undersigned at the telephone number listed below.

Respectfully submitted,

  
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